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909 7590 08/04/2009 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER POND, ROBERT M				
ART UNIT 3625		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/821,040

**Applicant(s)**

SONDEREGGER ET AL.

**Examiner**

Robert M. Pond

**Art Unit**

3625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-9, 21, 22 and 24, 25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 21, 22, 24, 25, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Reopening of Prosecution***

In view of the Appeal Brief filed on September 2, 2008, PROSECUTION IS  
HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the  
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply  
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed  
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and  
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth  
in 37 CFR 41.20 have been increased since they were previously paid, then appellant  
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by  
signing below:

/Jeffrey A. Smith/

Supervisory Patent Examiner, Art Unit 3625

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn as necessitated by new grounds of rejection.

### ***Response to Arguments***

Applicant's arguments filed with the Appeal Brief regarding Flitcroft have been fully considered but they are not persuasive for the following reasons:

#### **Appellants: Pages 9-10**

Flitcroft does not disclose at least the feature of "receiving the anonymous credit card from the credit card issuer, the anonymous credit card having an anonymous transaction number that functions as a credit card number and an expiration date based on a month and a year in which the on-line transaction occurs," as recited in independent claim 1, for example. However, the Examiner alleges that "Flitcroft discloses a range of over one trillion," which is alleged to be "[s]ufficient to address the claimed subject matter." Final Action, page 5. Appellants disagree with the Examiner's assessment.

Appellants note that the claimed invention expressly recites the characteristics of anonymous credit cards received from the credit card issuer. Specifically, the anonymous credit cards are recited as "having an anonymous transaction number that functions as a credit card number and an expiration date based on a month and a year in which the on-line transaction occurs." Because the anonymous credit cards are linked to the month and year in which the

transaction occurs, "the credit card issuer can issue at least one trillion unique credit cards per month." Appellants' Specification, page 5. In contrast, the passages of Flitcroft that the Examiner relies upon specifically state that "the expiration date is virtually irrelevant," which creates a limit of "1,200 billion possible unique codes available for any given credit card provider." Flitcroft, page 23.

- The Examiner respectfully disagrees with Appellants' arguments noted above:
  - The entity operating the Flitcroft system at least is an "other credit card issuing entity" using the Internet to facilitate on-line single-use credit card transactions. (definition of credit card issuer can be found in the instant specification on page 3, lines 19-22); Flitcroft: abstract; Fig. 1; pg 6, lines 24-32; pg 7, line 1-pg 8, line 23; pg 13, lines 20-24; pg. 19, line 15-25 (issuing bank).
  - Flitcroft system issues one or more single-used credit card numbers associated with the users master credit card number at the user's request. Flitcroft: abstract; pg. 18-pg 21, line 20.
  - Flitcroft's single-use credit card has an expiration date; expiration dates are disclosed to be a month/year combination. The single-use credit card number is deactivated once the single use event occurs. Flitcroft is clear that a deactivate single-use credit card number, once deactivated, has expired. Claimed subject matter of

"having an anonymous transaction number that functions as a credit card number and an expiration date based on a month and a year in which the on-line transaction occurs" is mentioned on page 5 lines 3-6. From this, a conclusion is drawn by the Appellants that the credit card issuer can issue at least one trillion unique credit cards per month. The Examiner firmly believes that the Flitcroft system behaves the same way as disclosed by the Appellants. For example, a user activates the browser icon, requests a single-use credit card number and then completes a transaction. This results in the deactivation of the single-use credit card number in the month and year of the transaction. As with Appellants' invention, the deactivated credit card number expired on the at least the month and year of the transaction, the month and year not to exceed the expiration date of the master credit card number.

- Flitcroft discloses over 1 trillion unique numbers per card issuer of which each number expires based on a deactivation event or expiry date of the master credit card number or single-use expiry date. Flitcroft: Fig. 2; pg 4, lines 1-24; pg. 17, line 13.
- The basis for the overarching argument by Appellants' can be found on page 5, lines 3-6 of the instant specification. This supporting disclosure does not expressly, implicitly or inherently disclose that issued single-use credit card numbers expire at the

end of the issue month and year. Therefore it is the Examiner's interpretation that Appellants' claimed invention suffers the same potential problems alleged to occur with Flitcroft. For example, both can issue single-use credit cards in which transactions can occur either at the time the single-use credit card is requested or at a later date, a transaction date that may or may not occur the same month and year of the issue month and year. Appellants' drawing do not offer any additional information to clarify the claim subject matter.

Appellants: Pages 10-11

Although Flitcroft describes a system in which the quantity of anonymous credit card numbers may approximate one trillion "for any given credit card provider," which may "allow for a sufficiently large number of available card numbers," Flitcroft also acknowledges that "numbers will eventually need to be recycled for allocation . . . to ensure that the allocation process is performed from a range sufficiently large to maintain random allocation." Flitcroft, pages 23-24. In other words, because Flitcroft fails to disclose anonymous credit cards with "an expiration date based on a month and a year in which the on-line transaction occurs," the system in Flitcroft includes extensive "allocation requirements" designed to "achieve true computational independence between account numbers and limited-use cards." Flitcroft, pages 19-20.

Due to the aforementioned constraints, Flitcroft notes that "the range of available numbers reduces in size over time," meaning that "additional or recycled numbers should be added back into this range to ensure that the allocation process is performed from a range sufficiently large to maintain random allocation." Flitcroft, page 24. As indicated above, the claimed invention takes a different approach, wherein anonymous credit cards are assigned "an expiration date based on a month and a year in which the on-line transaction occurs." As such, the claimed invention provides a mechanism whereby the available pool of unique anonymous credit cards will reset each and every month, substantially reducing (or eliminating) the need to track and recycle anonymous credit card numbers to ensure random allocation.

- The Examiner respectfully disagrees with Appellants arguments for the reasons noted above and following: Appellants' single-use number are recycled as suggested by arguments and the instant specification page 5, lines 7-10.

Appellants: Page 11

Furthermore, the claimed invention limits the period of time in which potential fraud may occur by constraining the expiration date of the anonymous credit cards to the month and year of issuance. Although Flitcroft describes the importance of fraud detection mechanisms, Flitcroft does not disclose placing constraints on the expiration date of the anonymous credit card numbers to reduce the likelihood of fraud. Rather, Flitcroft describes techniques such as



waiting "a sufficiently long time" before reactivating a limited-use number or limiting "the number of single use numbers declared to be valid at any one time." Flitcroft, pages 17 and 22. Thus, Flitcroft does not disclose anonymous credit cards being given "an expiration date based on a month and a year in which the on-line transaction occurs," either as a mechanism for ensuring the continuing availability of a large number of anonymous credit cards or for limiting the period of time in which fraudulent usage of the anonymous credit cards may occur.

- The Examiner respectfully disagrees with the Appellants' argument. The thin disclosure provided by the Appellants' on page 5, lines 3-6 does not expressly, implicitly or inherently disclose that single-use credit cards issued expire at the end of the issue month and year. Therefore it is the Examiner's interpretation that Appellants' claimed invention suffers the same potential problems alleged to occur with Flitcroft. For example, both can issue single-use credit cards in which transactions can occur either at the time the single-use credit card is requested or at a later date, a transaction date that may or may not occur the same month and year of the issue month and year.

Regarding claim 26. Arguments were persuasive. See below- Allowable Subject Matter.

Appellants' arguments, see Appeal Brief, filed 02 September 2008 with respect to the rejection(s) of claim(s) 3, 4, 8, 9, 21, 22, 24, 27 and 28 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the

rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Flitcroft and Stolfo. Arguments pertaining to Zucker and/or Livesay as supporting references are moot. Both are withdrawn.

***Claim Rejections - 35 USC § 101***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 1. Claims 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Applicants are claiming a system defined merely by software or terms synonymous with software or files such as "modules" or "interface." Software requires a tangible embodiment for code or instructions in computer readable medium causing a processor to execute the method. Examination was based on the assumption that structural specificity employing computer(s), input/output apparatus, computer-readable medium, as supported explicitly, implicitly or inherently by the instant specification, is in play. Correction is required to overcome the rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Applicants are claiming a system defined merely by software or terms synonymous with software or files such as "modules" or "interface" and therefore are not therefore not pointing out and distinctly claiming the subject matter regarded as the invention. Software requires a tangible embodiment for code or instructions in computer readable medium causing a processor to execute the method. Examination was based on the assumption that structural specificity employing computer(s), input/output apparatus, computer-readable medium, as supported explicitly, implicitly or inherently by the instant specification, is in play. Correction is required to overcome the rejection.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 3. Claims 1-4, 6-9, 21, 22, 24, 25, 27 and 28 are rejected under 35 USC 103(a) as being unpatentable over Flitcroft (WO 99/49424) in view of Stolfo (US 7,069,249).**

Flitcroft teaches a system and methods of issuing single-use or limited-use credit card numbers assigned to a card holder's master credit card number without revealing the master credit card number to maintain the user's privacy. See at least abstract; Figs. 1-15; page 5, line 29-page 6, line 32; page 33, lines 12-17; page 7, line 1-page 8, line 23; page 13, lines 20-24; page. 18, line 15-page 21, line 20; page 19, lines 15-25 (issuing bank). Flitcroft further teaches: Regarding claim 21: Anonymous credit card

- Regarding claim 21. displaying an anonymous shopping toolbar in a browser, the anonymous shopping toolbar providing a user with an anonymous credit card option. icon activated from browser. See at least Fig. 6; page 33, lines 12-17.
- Regarding claim 21. communicating, to a credit card issuer, a request for an anonymous credit card, the request for the anonymous credit card communicated in response to the user selecting the anonymous credit card option; user clicks an icon to activate software to communicate with the credit card issuer. The entity operating the Flitcroft system at least is an "other credit card issuing entity" using the Internet to facilitate on-line single-use credit card transactions. (definition of credit card issuer can be found in the instant specification on page 3, lines 19-22); Flitcroft: abstract; Fig. 1; pg 6, lines 24-32; pg 7, line 1-pg 8, line 23; pg 13, lines 20-24; pg. 19, lines 15-25 (issuing bank). Flitcroft system issues one or more single-used credit card numbers associated with the users master

credit card number at the user's request. Flitcroft: abstract; pg. 18, line 15-  
pg 21, line 20.

- Regarding claim 21. receiving the anonymous credit card from the credit card issuer, the anonymous credit card having an anonymous transaction number that functions as a credit card number, an expiration date based on a month and a year in which the on-line transaction occurs, an alias that substitutes for the user's real name, and a purchase limit based on an amount of the online transaction, whereby the credit card issuer can issue about one trillion unique anonymous transaction numbers per month, wherein the user can anonymously initiate the on-line transaction using the anonymous credit card, and wherein the credit card issuer links the anonymous transaction number to the user's real credit card account;
  - Flitcroft's single-use credit card has an expiration date; expiration dates are disclosed to be a month/year combination. The single-use credit card number is deactivated once the single use event occurs. Flitcroft is clear that a deactivate single-use credit card number, once deactivated, has expired. Note: Claimed subject matter of "having an anonymous transaction number that functions as a credit card number and an expiration date based on a month and a year in which the on-line transaction occurs" is mentioned on page 5 lines 3-6. From this, a conclusion is drawn by the Appellants that the credit card issuer can issue at least one trillion unique credit cards per month. The Examiner

firmly believes that the Flitcroft system behaves the same way as disclosed by the Appellants. For example, a user activates the browser icon, requests a single-use credit card number and then completes a transaction. This results in the deactivation of the single-use credit card number in the month and year of the transaction. As with Appellants' invention, the deactivated credit card number expired on the at least the month and year of the transaction, the month and year not to exceed the expiration date of the master credit card number.

- Regarding purchase limit, the single-use card number can trigger a deactivation event based individual transaction amount. Flitcroft: see at least page 7, line s 1-11.
- Flitcroft discloses over 1 trillion unique numbers of which each number expires based on a deactivation event or expiry date of the master credit card number or single-use expiry date. Flitcroft: Fig. 2; pg 4, lines 1-24; pg. 17, line 13.
- The basis for the overarching argument by Appellants' can be found on page 5, lines 3-6 of the instant specification. This supporting disclosure does not expressly, implicitly or inherently disclose that issued single-use credit card numbers expire at the end of the issue month and year. Therefore it is the Examiner's interpretation that Appellants' claimed invention suffers the same potential problems alleged to occur with Flitcroft. For example, both can issue single-use credit cards in which

transactions can occur either at the time the single-use credit card is requested or at a later transaction date, wherein the transaction date that may or may not occur the same month and year of the issue month and year. Appellants' drawings do not offer any additional information to clarify the claim subject matter.

- Regarding claim 21. See alias below.

Regarding claim 21: Anonymous delivery service

Stolfo teaches a system and method of conducting transactions between a first party (e.g. customer), a second party (e.g. seller, vendor) and a shipping service provider while preserving the first party's anonymity against i) proprietors of the web sites that the user may visit, ii) the online second party vendors from whom the user orders or purchases goods, and iii) shippers except for the last hop shipper that delivers a good to an address designated by the user. See at least abstract; col. 10, lines 11-38; col. 13, lines 11-16; col. 21, line 35-col. 25, line 60; col. 29, lines 39-col. 32, lines 15. Stolfo further teaches:

- Regarding claim 21. displaying an anonymous shopping toolbar in a browser, the anonymous shopping toolbar providing a user with an anonymous delivery option for the user to anonymously initiate an on-line transaction; proxy software icon located on user's browser is clicked by the first party (i.e. customer) to initiate an online delivery transaction. User elects to shop privately by actively clicking an icon, button, book mark or

other favorites or by some other typical means provided on the browser.

See at least col. 21, line 35-col. 22, line 65.

- Regarding claim 21. communicating, to a delivery service, a request for an anonymous delivery address, the request for the anonymous delivery address communicated in response to the user selecting the anonymous delivery option: See at least col. 21, line 35-col. 23, lines 36.
- Regarding claim 21. receiving the anonymous delivery address from the delivery service, the anonymous delivery address associated with the delivery service and having a routing code embedded therein, wherein the user can anonymously initiate the on-line transaction using the anonymous delivery address, and wherein the delivery service receives a delivery at the anonymous delivery address in response to the on-line transaction and uses the embedded routing code to route the delivery to the user's real delivery address. The good may be a physical good and the delivery address is a physical address of a physical facility, where the good is physically delivered. The delivery address may be that of a depot, where the good may be made available for pick up by or on behalf of the first party in a manner which does not require said information of the first party to be revealed at the physical facility. Alternatively, delivery to a physical address, which may not secure said information of the first party, designated by the first party may be provided for by delivering first to a first physical address (e.g., a depot), without revealing the private and



personal information of the first party to the second party and unauthorized parties, and then trans-shipping to a second or last physical address designated by the first party but not revealed to the second party. The first physical address, given to the second party, does not reveal the private and personal information of the first party. Although the second physical address may reveal such information, it is made known at the first physical address and not given to the second party. Alternatively, the delivery address may be a proxy address that does not reveal the true physical address of the first party and that may be converted or mapped by a shipper to the true physical address to which the good is to be delivered as designated by the first party. Shipment to the first delivery address may be referred to as a "first hop" shipment, and shipment to the second physical address designated by the first party may be referred to as a "second hop" or "last hop" shipment. See at least col. 10, lines 11-38; col. 13, lines 1-col. 14, lines 14.

Flitcroft teaches and suggests all the above as noted under the 103(a) rejection and teaches i) maintaining user privacy in conducting online transactions by issuing one or more credit card numbers associated with the user's main credit card account and ii) the user submitting only the credit card number as identifying information. Although Flitcroft does not mention use of an alias by the user, Stolfo on the other hand teaches and suggests all the above as

noted under the 103(a) rejection and further teaches use of an alias by the user. Stolfo: see at least col. 8, lines 17-30. One of ordinary skill in the art at time the invention was made would have recognized that applying the known techniques of Stolfo's proxy identifier as an alias would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the techniques of Stolfo to the teachings of Flitcroft would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. vs. Teleflex Inc.* An alias provides additional privacy/security for the Flitcroft system.

Flitcroft and Stolfo teach and suggest all the above as noted under the 103(a) rejection and each teach displaying an anonymous shopping toolbar in a browser activating an icon or other browser feature to use a software application (e.g. anonymous credit card, anonymous delivery) accessible from the browser. It would have been obvious to one of ordinary skill in the art at time of the invention that both software features could be activated from the same browser, in order to provide a user convenience of using only one open browser versus two open browsers.

- Regarding claims 1, 4, 6 and 9. Rejections are based on the teachings and rationale as noted above for claim 21.

- Regarding claims 2 and 7. Rejections are based on the teachings and rationale as noted above for claim 21.
- Regarding claims 3 and 8. Rejections are based on the teachings and rationale as noted above for claim 21.
- Regarding claim 4. Rejection is based on the teachings and rationale as noted above for claim 21.
- Regarding claim 22. Rejection is based on the teachings and rationale as noted above for claim 21. Stolfo mentions a bank acting as a delivery service. Solfo: see at least col. 18, lines 27-29.
- Regarding claim 24. Rejection is based on the teachings and rationale as noted above for claim 21 further supported by Flitcroft teachings.
- Regarding claim 25. Rejection is based on the teachings and rationale as noted above for claim 21 further supported by Flitcroft teachings. Flitcroft: see at least See at least page 19, lines 15-25; page 23 line 4- page 24, line 8.
- Regarding claims 27 and 28. Rejections are based on the teachings and rationale as noted above for claim 21 and as further supported by Stolfo. Trans-shipping/hop & depot. Stolfo: see at least col. 10, lines 11-38; col. 19, line 66-col. 20, line 2; col. 23, lines 16-31.

***Allowable Subject Matter***

4. Claim 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M. Pond/  
Primary Examiner, Art Unit 3625  
August 2, 2009